REMARKS

The Applicants have reviewed the Examiner's Office Action of October 7, 2005 and have the following comments.

Claim Amendments

Applicants emphatically do not agree that the claims concerning which the Examiner alleged lack of enablement were unpatentable in that form. However, solely in order to expedite prompt allowance of the Applicants' preferred embodiment of the invention Applicants have, without prejudice to presenting the original claims in a continuation or divisional application, amended claim 13, the sole independent claim, to indicate that the alpha 2 adrenergic agonist has alpha 2B adrenergic activity. Basis for this amendment is found in the claims as filed, and in the specification at, e.g., page 9.

Claims 19 and 20 have been amended to indicate that the alpha 2 selective agonist is administered in the form of an intraocular implant. Support for this claim is found, e.g., in Example 2.

Enablement

The Examiner has rejected method claims 13, 14 and 17-25 as allegedly lacking enablement because "the specification, while being enabled for certain alpha 2 selective agonists capable of protecting ocular neural tissue from damage, does not reasonably provide enablement for all alpha 2 selective agonists capable of protecting ocular neural tissue from damage." Respectfully, Applicants are not entirely certain what this statement intends, or which compounds the Office Action alleges are enabled or not enabled. Applicants shall interpret the quoted language to allege

that that the claimed method employs alpha 2 selective adrenergic agonists, some of which, but not all of which, have been shown by the present specification to possess the property of protecting ocular neural tissue from damage, and to further allege that the claims lack enablement due to this fact. Applicants respectfully but strongly disagree.

The enablement requirement requires that one of ordinary skill in the art could make and use the invention from the information disclosed in the patent application, together with information contained in the prior art, without undue experimentation. See e.g., MANUAL OF PATENT EXAMINING PROCEDURE § 2164.01. The fact that experimentation is complex does not make it undue if those in the art typically engage in that type of experimentation. *Id.*; see e.g., *In re Wands*, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)(emphasis added). Furthermore, a patent specification "need not teach, and preferably omits, what is well-known in the art." *Spectra-Physics, Inc. v. Coherent, Inc.*, 3 USPQ2d 1737 (Fed. Cir. 1987) (quoting *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 231 USPQ 81 (Fed. Cir. 1986) (emphasis added).

The present claims are, of course, method claims; the methods comprise a single "delivering" step. The October 7, 2005 Office Action agrees that the specification, in light of the prior art, enables this delivering step since the Office Action indicates that the claimed methods are enabled for "certain" alpha 2 adrenergic agonists. The delivering step is the same regardless of the drug delivered; thus, if the specification teaches one of skill in the art how to deliver one compound for a certain purpose, in so doing it must teach one of skill in the art how to carry out the method using all the compounds mentioned in the claims.

The Office Action indicates that Applicants have admitted that alpha 2 adrenoreceptor have been classified alpha 2A, alpha

2B and alpha 2C. This is true; indeed the claims as originally filed contained such a distinction. However, Applicants believe that the rejected claims are entirely patentable as they stand; it is a matter of black letter law that "it is not a function of the claims to specifically exclude possible inoperative substances." *Atlas Power Co. v. E.I. Du Pont de Nemours & Co.*, 224 USPQ 409 (1984)(citations omitted).

Nevertheless, given the lengthy prosecution of this application and the Applicants earnest desire to obtain allowance of claims directed to preferred embodiments of the invention, Applicants have amended the claims to indicate that the alpha 2 selective agonists have alpha 2B receptor activity. Such amendments are made without prejudice to any claims that may be advanced in a continuation or divisional application claiming priority to the present application.

Applicants point out that the present specification must be deemed to include the disclosure of, inter alia, commonly owned U.S. Patent 6,313,172 and published international patent applications WO 01/78703, WO 01/78702, WO 01/00586, and WO 99/28300, all of which were incorporated by reference as part of the present specification on page 16 of the specification, which give examples and disclosure of various alpha 2 selective compounds having neuroprotective activity. Thus, the present specification clearly enables the presently amended claims.

CONCLUSION

For the foregoing reasons the Applicants respectfully ask the Examiner to withdraw the rejection and permit the claims to proceed to issue.

Should any fee be due in connection with this communication kindly use Deposit Account 01-0885 for the payment thereof.

Respectfully submitted,

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